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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,616	11/27/2001	Kazuhiro Akutsu	1075.1183	8236
21171 7590 07/17/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER KESACK, DANIEL	
			ART UNIT 3691	PAPER NUMBER
			MAIL DATE 07/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/993,616	Applicant(s) AKUTSU ET AL.	
	Examiner Dan Kesack	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-19 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/26/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This application has been reviewed. Claims 1-19, and 26-33 are currently pending. The rejections are as stated below.

Election/Restrictions

2. Claims 20-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 24, 2007.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 27, 29, 31-33 are rejected under 35 U.S.C. 102(a) as being anticipated by the Atlas ATM website, as retrieved from the Wayback Machine (www.archive.org) from April 21, 2001, hereinafter *Atlas*.

Art Unit: 3691

Claims 1, 27, 29, 31-33, Atlas discloses determining an ATM placement fee which is to be paid to the fee recipient entity, based on electronic history information obtained from said ATM. Atlas discloses sending a commission check wherein the commission is a function of the number of transactions being performed on said ATM. The amount of the commission check is therefore inherently based on electronic transaction history obtained from the ATM, and therefore the electronic transaction history information is inherently obtained from the ATM in order to calculate said commission. Atlas further discloses that the ATM is installed in a nonblank location, and is under a payment-by-results contract.

Claims 2, 3, Atlas discloses the electronic transaction history information is a transaction history about the transactions performed on the ATM, wherein the transaction history is defined in terms of the number of transactions that have been performed on the ATM.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 4-9, 28, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas, in view of Steinmetz et al., U.S. Patent No. 6,672,505.

Atlas fails to teach the electronic history information being the total sum of money that has been transacted on the ATM, the total length of time during which the ATM has been kept in proper condition for service.

Steinmetz discloses an automated banking machine configuration system and method, wherein an ATM license authority communicates with an ATM through a communications network (figure 1), and wherein the license authority collects data on ATMs and keeps track of the operation and use in order to properly assess licensing and support fees, wherein the data collected comprises functions performed, the time of operation, and the number of transactions conducted, and other data or combinations thereof (column 15 lines 61 – column 16 line 20). While Steinmetz does not explicitly mention a total sum of money transacted, one of ordinary skill in the art can appreciate that it would be obvious to keep track of this number within an ATM, and that the total sum of money may be considered “other data” as taught by Steinmetz. It would have

been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atlas to include determining the commission fee based on said data because one who is looking for metrics on which to base such a commission would be motivated to look to the data which is commonly collected from an ATM remotely by a licensing authority, and would readily contemplate any combination of said data.

8. Claims 10-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atlas and Steinmetz, as applied above, and further in view of Drummond et al., U.S. Patent No. 6,796,490.

Atlas and Steinmetz fail to teach an ATM including browsing capabilities, and determining a placement fee based on said browsing history.

Drummond discloses an automated banking machine wherein the machine is also a toll access server to the Internet, providing Internet browsing capabilities (column 3 lines 25-46). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atlas and Steinmetz to include the Internet access capabilities of Drummond because Drummond teaches the ATM operator charges for the service, and this would produce an additional stream of revenue for the ATM operator. It would then be obvious to obtain the browsing history information in a manner similar to that of Steinmetz because the Internet access would be considered a transaction operated on the ATM. It is also noted that Steinmetz and Drummond are commonly owned by Diebold, Inc.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Serziger, U.S. Patent Application Publication No. 2002/0082994 is directed towards a method and apparatus for managing automated banking machines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



HANI M. KAZIMI
PRIMARY EXAMINER